

Atty Dkt. No.: R0066C DIV
USSN: 10/667,281

REMARKS

Claims 34 and 35 are pending in the above-identified patent application. Claim 33 has been canceled by this Amendment, and claims 34 and 35 are amended herein. No new matter is introduced.

1. Priority

The Applicants were invited to amend page 1 of the specification to include the status of intervening application Ser. No. 09/586,559. Applicants have amended the first paragraph of the specification to indicate that application Ser. No. 09/586,559 has been granted as U.S. Patent No. 6,649,377.

2. Claim Objections

Claim 33 was objected to because of the lack of an indefinite article at the beginning of the claim. Claim 33 has been canceled.

3. Claim Rejections Under 35 USC §112, First Paragraph

Claims 33-35 were rejected under 35 USC §112, first paragraph for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 33-35 were also rejected under 35 USC §112, first paragraph because the specification, while enabling for the aggregation of the sequence set forth in SEQ ID NO: 2, does not reasonably provide enablement for preparation of divergent aggrecanases and aggrecanase fragments that retain proteolytic activity.

Applicants have canceled claim 33, and have amended claims 34 and 35 in the manner indicated by the Examiner as being allowable, to limit claims 34 and 35 in scope to the amino acid sequence of SEQ ID NO: 2. As amended, claim 34 is placed in independent form and recites "An isolated aggrecanase comprising the amino acid sequence set forth in sequence of SEQ ID NO: 2". Claim 35 as amended is in independent form and recites "An isolated aggrecanase that consists of the amino acid sequence set forth in SEQ ID NO: 2".

Applicants believe that claims 34 and 35 as amended meet the criteria of 35 USC §112, first paragraph.

Atty Dkt. No.: R0066C DIV
USSN: 10/667,281

4. Claim Rejections Under 35 USC §112, Second Paragraph

Claims 34-35 were rejected under 35 USC §112, second paragraph as being indefinite for depending on a canceled claim, because of the recitation "substantially", and because of the recitation of "SEQ ID NO: 1" instead of the correct "SEQ ID NO: 2". Claims 34 and 35 have been amended as described above to remove the indefinite language noted by the Examiner. Applicants apologize for these errors.

5. Claim Rejections Under 35 USC §102

Claims 33-35 were rejected under 35 USC §102 as being anticipated by Moore et al., WO 98/56804, Holtzman et al., WO 99/37660, Jonak et al., EP 874050, and Ieruela-Arispe et al., US2003/0092900, each of which was indicated by the Examiner as disclosing polypeptides having substantial similarities to the polypeptide(s) recited in Applicants claims 33-35.

As noted above, claim 33 has been canceled and claims 34 and 35 have been amended limit the claims to SEQ ID NO: 2, which the Examiner indicated would be allowable. Accordingly, Applicants believe that claims 34 and 35 are patentable over Moore et al., WO 98/56804, Holtzman et al., WO 99/37660, Jonak et al., EP 874050, and Ieruela-Arispe et al., US2003/0092900.

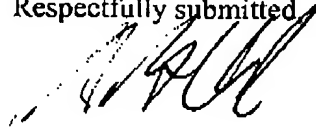
Atty Dkt. No.: R0066C DIV
USSN: 10/667,281

CONCLUSION

In view of the foregoing, Applicants respectfully believe that all claims pending in the above-identified case are now in condition for allowance. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Applicants request a one month extension of time for reply pursuant to 37 CFR §1.136(a). Please charge Applicants' deposit account No. 18-1700 for the requisite fee of \$120.00 as set forth in 37 CFR §1.17(a)(1).

Respectfully submitted,



Robert C. Hall
Reg. No. 39,209
Attorney for Applicants

Roche Palo Alto
Patent Department, MS A2/250
Palo Alto, CA 94301
(650) 354-7540

January 18, 2006